

REMARKS

The Office Action mailed July 27, 2004 has been reviewed and carefully considered. Claims 1-14 remain pending, of which the independent claims remain 1, 3, 5, 8 and 11. Claims 1 and 3 have been amended. Independent claims 5, 8 and 11 have not been amended. Reconsideration of the above-identified application, as amended and in view of the following remarks, is respectfully requested.

Claims 1-14 stand rejected under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 6,208,854 to Roberts et al. ("Roberts").

Claim 5 recites:

A method for establishing a call connection between a calling terminal and a receiving terminal in a telecommunication network having a call forwarding service, comprising the steps of:
pre-programming each terminal of said network to accept or refuse said call connection performed through said call forwarding service;
determining whether to establish said call connection when said calling terminal originates a call to said receiving terminal through said call forwarding service; and
establishing said call connection between said calling terminal and said receiving terminal if said calling terminal is pre-programmed to establish said call connection through said call forwarding service.

Item 3, page 3, of the Office Action refers to lines 15-31 of column 2 of Roberts as being relevant to claim 5.

Roberts, in the passage cited by the Office Action, merely discloses that computer-readable code resides in networks that collectively connect (a) a calling party; (b) the called party's landline communication unit; and (c) the called party's wireless communication unit (FIG. 2). This does not amount to disclosure or suggestion of pre-programming a "terminal of said network."

Nowhere does Roberts disclose or suggest “pre-programming each terminal of said network” which language explicitly appears in claim 5 of the present invention.

Item 3 of the Office Action, on page 3, acknowledges that the “terminal of said network” in the present claim 5 can, at best, be compared only to the landline or wireless device 210, 220, 230 of Roberts.

Although Roberts discloses that the called party may engage or disengage the wireless/land-line call routing service by means of the IVR unit (col. 5, line 24), this, at best, amounts to pre-programming a called (col. 5, line 25: “called”) terminal. Even at that, the pre-programming is not “to establish said call connection” which limitation appears explicitly in present claim 5.

In addition and by way of further contrast, there is no disclosure or suggestion that the Roberts calling terminal experiences “pre-programming . . . to accept or refuse said call connection.”

It is also unclear in what sense Roberts discloses or suggests that a terminal may be “pre-programmed to establish said call connection” or may not be. There is no disclosure or suggestion in Roberts that the code in the networks 240 shifts and changes dynamically. Whether or not a call is put through in Roberts depends upon dynamic conditions, e.g., whether a mobile phone is currently available or in use, rather than upon whether or not subscribers are “pre-programmed to establish said call connection.” The prefix “pre” in the word “pre-programming” cannot be ignored.

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). MPEP 2143.03.

For at least the above reasons, Roberts fails to anticipate the invention as recited in claim 5. Reconsideration and withdrawal of the rejection is respectfully requested.

Claim 8 likewise recites that “said receiving terminal is pre-programmed to establish said call connection through said call forwarding service.” Roberts makes no such suggestion or disclosure. At best, Roberts discloses disengaging from a call forwarding service by engaging an unconditional call forwarding (col. 5, lines 27-29).

For at least the above reasons, Roberts fails to anticipate the invention as recited in claim 8. Reconsideration and withdrawal of the rejection is respectfully requested.

Claim 11 recites:

determining whether said calling subscriber and said terminating subscriber are pre-programmed to establish said call connection . . . selectively establishing said call connection if said calling subscriber and said terminating subscriber are pre-programmed for said call connection . . .

It is unclear from Roberts who or what is doing the determining or why.

It is also unclear in what sense Roberts discloses or suggests that a subscriber may be “pre-programmed to establish said call connection” or may not be. There is no disclosure or suggestion in Roberts that the code in the networks 240 shifts and changes dynamically. Whether or not a call is put through in Roberts depends upon dynamic conditions, e.g., whether a mobile phone is currently available or in use, rather than upon whether or not subscribers are “pre-programmed to establish said call connection.”

The prefix “pre” in the word “pre-programming” cannot be ignored.

For at least all of the above reasons, Roberts fails to anticipate the invention as recited in claim 11. Reconsideration and withdrawal of the rejection is respectfully requested.

Claim 1, as amended, recites:

pre-programming a calling terminal;
instructing, at said calling end and according to said pre-programming, as to whether to establish a call connection when an originating call is routed to a new number through said call forwarding service

As discussed above, Roberts has no disclosure or suggestion or pre-programming a calling terminal. Moreover, Roberts has no disclosure or suggestion of “instructing . . . according to said pre-programming, as to whether to establish a call connection when an originating call is routed to a new number . . .”

Support for the amendment of claim 1 is found in claim 5 and in the specification at page 2, lines 3-6 and at page 7, lines 1-4, 7-9.

Claim 3 as amended recites, “pre-programming a receiving terminal in a manner that selects between modes of performance within said call forwarding service.” Roberts, at best, determines whether or not the call forwarding service is active, but fails to disclose or suggest the above-quoted limitation. Support for the amendment of claim 3 is the same as that for claim 1, and, in addition, page 7, lines 10-13 in the specification.

Claims 1-4 stand rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,583,564 to Rao.

As to claim 1, Rao fails to disclose or suggest “pre-programming a calling

terminal.” For at least the above reasons, Rao fails to anticipate the invention as recited in claim 1.

Regarding claim 3, Rao fails to disclose or suggest “pre-programming a receiving terminal.” For at least the above reasons, Rao fails to anticipate the invention as recited in claim 3.

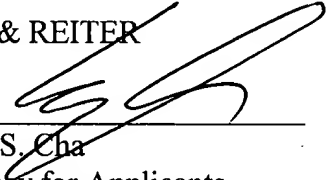
For the remaining rejected claims, each depends from a base claim and is deemed to be patentable for at least the same reason(s).

In view of the foregoing amendments and remarks, it is believed that this application is now in condition for allowance. The Examiner is invited to contact the undersigned in the event of any perceived outstanding issues so that passage of the case to issue can be effected without the need for a further Office Action.

In the event that any additional fee is required to continue the prosecution of this Application as requested, please charge such fee to Deposit Account No. 502-470.

Respectfully submitted,

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10/27/04

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